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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,881	06/05/2000	Mordhay Barkan		8240

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EXAMINER

DASS, HARISH T

ART UNIT PAPER NUMBER

3628

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/586,881

Applicant(s)

BARKAN, MORDHAY

Examiner

Harish T Dass

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 35-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/21/2004 has been entered.

**DETAILED ACTION**

Claims 1-14 and 15-34 are canceled.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36-40 and 41-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36-40 and 45-47 recite the limitation "tokens" (in 1<sup>st</sup> lines) of claims 36-40 and 45-47. There is insufficient antecedent basis for this limitation in the claim.

Note: "digital tokens" are different than tokens (i.e., metro tokens, etc.)

Claims 41-43 recite the limitation "second party", claim 41 line 4, claims 42-43 2<sup>nd</sup> line. There is insufficient antecedent basis for this limitation in the claim.

Claim 47 recites the limitation "third party", claim 47 line 4. There is insufficient antecedent basis for this limitation in the claim.

Claims 41-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claim 41, lines 13-14 the phrase "and/or" renders the claims indefinite because, it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). For purpose of examination only, Examiner assumes that the claim limitation is "or".

Claims 35-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 35, the phrase "where the user uses a service, in the user's possession, by the user" is vague and clear to examiner.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 35-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession

of the claimed invention. Particularly, in claim 35 "buyer's database" is not in original specification. Examiner finds closes phrase "his/her token database" or database, page 20 line No. 20 of specification.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 35-37 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Hill (US 6,236,981).

Re. Claim 35, Hill discloses acquiring by a user of digital tokens from the digital tokens issuer and storing the tokens in a buyer's database [C2 L2 to C4 L44; C5 L15-24, C5 L31-41; C8 L1-L17], and

canceling the used tokens (cleared tokens), that are being used by the user according to computerized predefined criteria, where the user uses a service, in the user's possession, by the user [Figure 10; C8 L18-31; C9 L6-L8, C9 L44-L67; C12-L8-L48; C13 L3-L6].

Re. Claim 36, Hill discloses wherein the tokens can be in different predefined values [C5 L31-L41; C12 L48-L67].

Re. Claim 37, Hill discloses wherein the tokens are cryptography protected from fraud [C2 L33-L35, C2 L52-L63].

Re. Claim 41, Hill discloses the user sends to the second party a report including information relating to the token used and canceled by the user while using the service for which a payment by tokens was required [figure C3 L13-L28; C4 L28-L33; C5 L12-L15; C6 L3-L60],

the second party maintains a database of previous reports relating to tokens used in the past, and the report received in step (a) is added to the database [C57-L76];

the second party compares the information received in step (a) with previous reports for the same user (verify) [C6 L33-L50], and if the comparison detects a violation of the rules for the use of tokens [C6 L48 to C7 L23], then the second party stores that information or displays a violation report or reports that to the tokens issuer, or sends a note to the user of such token [C11 L5061; C12 L15-L45].

Re. Claim 42, Hill discloses wherein in step (b) the second party maintains a database of previous reports relating to tokens used in the past by the user [C14 L40-L48].

Re. Claim 43, Hill discloses wherein in step (b) the second party maintains a database of previous reports relating to tokens used in the past by a plurality of other users [C14 L40-L48; C9 L9-L67].

Re. Claim 44, Hill discloses wherein in step (b) the database of previous reports is being updated to include the latest reports, and the oldest reports are deleted there from [C12 L34-L45; C10 L64 to C11 L7].

Re. Claim 45, Hill disclose wherein in step (d) one of the rules for use of tokens is that no token is allowed to be used twice (prevent double spending) [C12 L8-L27].

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hill, as applies to claim 41 above.

Re. Claims 46, Hill does not explicitly disclose wherein in step (d) one of the rules for use of tokens is that the serial number of successive tokens should be in ascending order, and wherein in step (d) one of the rules for use of tokens is that the serial number of issued tokens should correspond to a digital document or digital permit issued by. However these are business choice and an easy way to administer the used, stolen, lost and damaged digital tokens. For example, American Express issues traveler checks in different denomination values and serial numbers in ascending orders, which are assigned to customer. When customer uses a check and gives it to vendor he/she logs the check number serially in log sheet or in case a check is lost by customer or vendor, it can be reported to American Express by user ID and traveler check serial number which makes it easier for user/vendor as well as American Express to update their list. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures Hill and include serial number of successive tokens should be in ascending order to provide better accounting and management.

Claims 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill as applies to claim 41 above, in view of Business wire "Subscriber Computing Inc. Installs Real-Time Information System Suite For Douglas Telecommunications Inc.", Nov. 19, 1997 (hereinafter Subscriber).

Re. Claims 38-40, Hill does not explicitly disclose wherein the tokens can be generated by the user himself according to special and secure digital permit from the tokens issuer



and according to predefined criteria in different predefined values, wherein the service can be the usage of predefined software package that is in the user's possession, and wherein the service can be the usage of wireless resources or any other digital communication means to another user, while the collecting payment party is not involved in the communication. However, Subscriber discloses these steps [see entire document 3 pages; (licensees) (cellular solution) (software-based prepaid metered billing solution)] to provide license to users (carriers) for using Prepay service. Further software licensing is known, for example, Informix database is licensed to large companies, where they (companies) incorporate Informix database to their product and sell it to others. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures Hill and Subscriber to allow user (carriers) to provide prepaid digital token service in response to competitive issues.

### **Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

*US 5,987,430 to Van Horne et al, Nov. 16, 1999 "Communications network connection system and method" discloses a system and method for remotely connecting client computers to a communication network such as the Internet by way of a server system handling a plurality of client computers and having the capability of dynamically providing network connections to the client computers, separately billing usage time and tracking usage and preferably updating access software on the client computers, where track*

*system usage by the client systems, monitor log off times and activity times, determine billing amounts and charge respective billing accounts.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Souh can be reached on 703-308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass  
Examiner  
Art Unit 3628

*Harish T Dass*

2/28/05